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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,508	06/30/2003	William P. Addiego	SP03-070	2155
22928	7590	05/03/2005		
CORNING INCORPORATED				EXAMINER
SP-TI-3-1				NGUYEN, CAM N
CORNING, NY 14831				ART UNIT
				PAPER NUMBER
				1754

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/611,508	ADDIEGO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cam N. Nguyen	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on April 15, 2005 (an election).
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 20-37 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date August 26, 2003.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Applicant's election without traverse of Group I, claims 1-19, in the reply filed on April 15, 2005 is acknowledged.
2. Claims 20-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on April 15, 2005.

### ***Claim Objections***

3. Claims 17 & 19 are objected to because of the following informalities:
    - A. In claim 17, line 1, "silicone-containing" should be changed to –silicon-containing–.
    - B. In claim 19, line 1, "solid" should be deleted.
- Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112 (Second Paragraph)***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 14 & 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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A. Claim 14 recites the limitation "the bulk catalyst of claim 12" in line 1. There is insufficient antecedent basis for this limitation in the claim.

B. Claim 15 recites the limitation "the bulk catalyst of claim 12" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102(e)***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-3, 5-7, 10-14, & 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Davies et al., "hereinafter Davies", (US Pat. 6,793,728 B1).

Davies discloses a composition for coating a metal substrate which is intended to be fabricated or overcoated, said composition comprising a silica binder and zinc powder and/or zinc alloy, etc. (see col. 17, claim 1). Suitable binder materials including

the alkoxy silanes and/or orthosilicates, such as tetraalkoxysilane (see col. 7, ln 36- col. 8, ln 10).

Davies discloses the claimed supported catalyst, thus anticipates the claims.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 8-9, & 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davies et al., "hereinafter Davies", (US Pat. 6,793,728 B1), as applied to claims 1-3, 5-7, 10-14, & 17-19 above, and further in view of Birkenstock et al., "hereinafter Birkenstock", (US Pat. 4,407,733).

Davies discloses a composition as described above, except for the following differences.

Regarding claims 4 & 15, Davies does not disclose the claimed transition metals. However, it would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have employed such known transition metals to achieve an effective catalyst in Davies because they are known as useful catalytically active metals for making supported catalysts, as evidenced by Birkenstock (see Birkenstock at col. 20, claims 11-27).

Regarding claims 8-9 & 16, Davies does not disclose the claimed inert support

materials. It would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have utilized such known catalyst support in Davies because alumina has been shown by Birkenstock a useful catalyst support material for preparing similar catalysts (see Birkenstock at col. 20, claim 12).

***Citations***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form attached. All references are cited for related art.

***Conclusion***

11. Claims 1-37 are originally pending in the application. Claims 1-19 are rejected. Claims 20-37 are withdrawn due to nonelected (distinct) invention. No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 8:45 AM - 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn *can*  
April 28, 2005

*Cam Nguyen*  
CAM N. NGUYEN  
PRIMARY EXAMINER

AV-1754